

Application No. 10/823,203
Amdt. transmitted December 20, 2004
Reply to Office Action of December 3, 2004

054030-0056

REMARKS/ARGUMENTS

Following entry of the present paper, claims 8-11 remain pending in this application and claims 1-7 are withdrawn. Applicant reserves the right to pursue the subject matter recited in the withdrawn claims (i.e., Groups I and II) in one or more divisional applications.

RESTRICTION REQUIREMENT AND APPLICANT'S

ELECTION WITH TRAVERSE

In response to the Office Action mailed December 3, 2004, which addressed the issue of a separate restriction not communicated in a previous Action of September 9, 2004, applicant now elects for further prosecution the methods of Group III, as recited in claims 8-11, but respectfully traverses the restriction requirement and requests reconsideration of the same. In view of the present requirement, the election made by Applicant in the previous paper mailed October 4, 2004 is retracted and replaced by the election made herein.

Applicant submits that the inventions of Group I, II and III are not proper for restriction under 35 U.S.C. § 121. In order to make a proper restriction, the Examiner must provide an explanation supporting the conclusion that the search and examination of the entire application can not be made without serious burden on the Examiner. Applicant does not believe a serious burden has been prima facie established in this case. According to MPEP § 803, if search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it*

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includes claims to independent or distinct inventions. It is respectfully suggested that, upon careful consideration, the examination of Groups I, II and III can be made without serious burden to the Examiner even though such examination may include claims to independent or distinct inventions.

To rebut the prima facie showing of a serious burden, the Examiner is asked to consider the relatedness between the nucleic acids of Group II and corresponding proteins of Group I, which the respective nucleic acids encode. Based on the relationship between the polypeptides and nucleic acids, as claimed, applicant believes that search and examination of Groups I and II should be substantially co-extensive. In view of the inherent characteristics of the claimed subjects, one would not find it necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists (i.e., the scope of the Examiner's search would be substantially the same). As well, the method of identifying a compound (Group III) utilizes the polypeptides recited in claims 1-2 (Group I) such that search and examination of Groups I and III should likewise be co-extensive. Therefore, no serious burden should be imposed on the Examiner. Accordingly, restriction in this instance appears improper and re-consideration is respectfully requested.

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CONCLUSION

In view of the election and arguments presented herein, applicant respectfully requests re-consideration of the restriction requirement and examination of at least the elected invention on the merits. Applicant requests that the Examiner telephone the undersigned in the event a telephone discussion would be helpful in advancing the prosecution of the present application. The Director is authorized to charge any additional fees or underpayment of fees regarding this response, including extensions for reply, to Deposit Account 07-1509.

Respectfully submitted,

GODFREY & KAHN, S.C.

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By: 

Charles L. Leeck
Registration No. 50,343

Attorney of Record for Applicant
GODFREY & KAHN, S.C.
780 North Water Street
Milwaukee, WI 53202-3590
Telephone: 414-273-3500
Facsimile: 414-273-5198

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